UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/743,080 | 12/23/2003 | Atsushi Tomokuni | 247041US0 | 8103 |

22850 7590 03/26/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

| EXAMINER | |
|---|---|
| CHANNAVAJJALA, LAKSHMI SARADA | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1611 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 03/26/2009 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

***Response to Arguments***

1. Applicant's arguments filed on 3-2-08 have been considered but are not found persuasive.

Applicants argue that in spite of the description of an isotropic surfactant continuous phase, Watanabe fails to disclose 1-45 wt. % of a lipophilic amphiphile of a fatty alcohol, a fatty acid or a monoalkylphosphoric acid, as a component of the isotropic liquid phase exhibiting bicontinuous phase. It is argued that the deficiency of Watanabe has not been cured because EP '8901 teaches emollients and skin conditioning agents such as fatty acids and fatty alcohols, which have been identified by applicants as suitable lipophilic amphiphile. Applicants' arguments are not persuasive because applicants argue against the references individually and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Instant rejection is made over a combination of Watanabe and EP 910, where EP910 has been cited for the claimed fatty alcohol, a fatty acid.

With respect to the argument that the reference teaches EP 910 for emollients and applicants identified them as lipophilic amphiphile compounds, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). For instance, EP 910 teaches glycerine as a solvent, humectant and also

an emollient (page 4), and reads on the solvent of instant claim 1. Additionally, it is to be noted that EP 910 also teaches compositions containing isotropic dispersed water-in-oil emulsions. The claims of EP 910 are directed to an emulsion having an isotropic dispersed phase comprising water, petrolatum, emulsifier, and conditioning agents that includes fatty alcohols (see claims 1-3 of EP 910).

Applicants argue that Watanabe et al describes formation of a composition which exhibits a one-phase system or an isotropic surfactant continuous phase formed by associating a surfactant or a coexisting phase system of any of the gel phase, the liquid crystal phase or the isotropic surfactant continuous phase and the other phases, in the absence of a lipophilic amphiphile. It is argued that the careful selection of components, and the association a surfactant or a coexisting phase system and the other phases, would not suggest to those of ordinary skill in the art that an added lipophilic amphiphile could be incorporated into an isotropic liquid phase exhibiting a bicontinuous structure. Further it is argued that the evidence of the expected stability of the one-phase system of Watanabe et al. is found in the disclosure at column 1, lines 59-62 that a liquid crystal one-phase system has a heavy feeling at application because a liquid crystal structure is somewhat difficult to break.

Applicants' arguments are not persuasive because Watanabe not only teaches a liquid crystal phase but also states a co-existing phases of a liquid crystal phase and an isotropic surfactant continuous phase (abstract, col. 2, L 57- 67) and in particular, col. 3, L 1-9. The description of preparing a coexisting phase is further provided in col. 4, L 13-30 of Watanabe; in particular, in col. 6, L 63-67, for isotropic phase. Applicants refer to

the article of Yoshida and Kuneida (Journal of Oleo Science, 1991), to explain a tri-component system and argue that the incorporation of a fatty alcohol has been demonstrated to destabilize the lamella liquid crystal one-phase system. It is argued that Watanabe teaches careful construction of a highly stable one-phase system in the absence of a lipophilic amphiphile and the above evidence proves destabilization in the presence of an amphiphile. Therefore, it is argued that a skilled artisan would not expect to incorporating the lipophilic amphiphile of EP would result in an isotropic liquid phase exhibiting a bicontinuous structure. However, while the teachings of Yoshida and Kuneida have been considered, the above argument is not persuasive because, applicants only argue the teaching of Watanabe individually and instead the rejection is made over a combination of references. EP teaches fatty alcohols compositions containing isotropic dispersed water-in-oil emulsions. If applicants' arguments that the presence of fatty alcohol destabilizes the resulting emulsion, then the instant composition also should result in a destabilized composition and should not form a bicontinuous emulsion. On the other hand, while Watanabe teaches all components except amphiphile claimed, which is taught by EP 910, the comparative formulation of Yoshida and Kuneida reference only contains 3 components and not 5 components such as that claimed. Hence, the comparative evidence is not of the same scope of the instant claims or of the composition resulting from the teachings of Watanabe and EP 910. Therefore the rejection has been maintained.